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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,418	02/17/2000	Masumi Senoo	10992503-1	7752

22879 7590 08/12/2005

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EXAMINER

BRINICH, STEPHEN M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/506,418

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/506,414 **MAILED**
Filing Date: February 17, 2000
Appellant(s): SENOO ET AL. **AUG 12 2005**

Technology Center 2600

Steven R. Sponseller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/25/05.

Art Unit: 2624

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-12 & 14-18 stand or fall together because appellant's brief does not include a statement that this

Art Unit: 2624

grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6003069

CAVILL

12-1999

Appellant's admitted Prior Art (Specification: page 1, line 23 - page 2, line 6)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 & 14-18 rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 1/10/05.

(11) Response to Argument

Re claim 1, Appellant argues (5/25/05 Appeal Brief: page 6, line 26 - page 7, line 7) that Cavell does not teach or suggest that the printer separates a print task into multiple portions or that the printer sends print tasks to an external device. Appellant further argues (5/25/05 Appeal Brief: page 7, line 8 - page 8, line 2) that Appellant's admitted Prior Art does not teach or suggest the determination of whether the entire print

Art Unit: 2624

job can be processed by a printer or the sending of print tasks to an external device if it is determined that the printer cannot process them.

Examiner does not dispute these assertions concerning the teachings contained in these individual references. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further re claim 1, in addressing the combination of references upon which the outstanding rejection relies, Appellant argues (5/25/05 Appeal Brief: page 8, lines 3-14) that the combination of Cavill and Applicant's admitted Prior Art fails to teach or suggest a printer that sends a print job to an external rendering device if the entire print job cannot be processed by the printer. In particular, Appellant argues (5/25/05 Appeal Brief: page 8, lines 8-14) that neither of these references teaches or suggests that the printer may determine whether an entire print job can be processed or that the printer sends a print job to an external rendering device, and that the combination therefore fails to teach or suggest these features.

In response, Examiner notes that, as described in the outstanding Final Rejection, Cavill teaches a printer, a local

Art Unit: 2624

network computer, and an external server. The network computer of Cavill determines whether a print job can be locally processed by the local network computer, and if not divides the job and sends complex portions thereof to the external server.

The outstanding Final Rejection notes that the incorporation of a processor into a printer is known in the prior art (citing Appellant's admitted Prior Art as a teaching to this effect). Examiner takes the position that it would be obvious to one of ordinary skill in the art to incorporate the local network computer of Cavill into the printer of Cavill (providing advantages such as simplified setup and more compact packaging by avoiding the need to provide this computer as a separate element externally interfaced with the printer). Appellant's arguments do not directly address the obviousness of this specific modification (i.e. the incorporation of the Cavill local network computer into the Cavill printer as a single unit).

In the Cavill device *as modified in this manner as set forth in the outstanding Final Rejection*, the disclosed functions of the Cavill local network computer are performed by an element integrated into the printer. These functions include the determination of whether a print job can be locally processed and the sending of print jobs that cannot be performed

Art Unit: 2624

locally to an external rendering device. Thus, in the Cavill device as modified in the manner set forth in the outstanding Final Rejection, the printer performs the operations of determining whether a print job can be locally processed and sending complex jobs to an external rendering device (the external server).

Re claim 8, Appellant argues (5/25/05 Appeal Brief: page 9, lines 1-10) that Cavell does not teach or suggest that the printer separates a print task into multiple portions or that the printer sends print tasks to an external device. Appellant further argues (5/25/05 Appeal Brief: page 9, lines 11-16) that Appellant's admitted Prior Art does not teach or suggest the determination of whether the entire print job can be processed by a printer or the sending of portions of a print job to an external device if it is determined that the printer cannot process them.

As argued above re claim 1, Examiner does not dispute these assertions concerning the teachings contained in these individual references. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 2624

Further re claim 8, in addressing the combination of references upon which the outstanding rejection relies, Appellant argues (5/25/05 Appeal Brief: page 9, lines 17-25) that the combination of Cavill and Applicant's admitted Prior Art fails to teach or suggest a printer that identifies portions of a print job that cannot be processed by the printer and sending these portions to an external rendering device. In particular, Appellant argues (5/25/05 Appeal Brief: page 9, lines 23-25) that neither of these references teaches or suggests that the printer may identify portions of a print job that cannot be processed by the printer or that the printer sends such portions of a print job to an external rendering device, and that the combination therefore fails to teach or suggest these features.

As argued above re claim 1, Examiner notes that, as described in the outstanding Final Rejection, Cavill teaches a printer, a local network computer, and an external server. The network computer of Cavill determines whether a print job can be locally processed by the local network computer, and if not divides the job and sends complex portions thereof to the external server.

The outstanding Final Rejection notes that the incorporation of a processor into a printer is known in the

Art Unit: 2624

prior art (citing Appellant's admitted Prior Art as a teaching to this effect). Examiner takes the position that it would be obvious to one of ordinary skill in the art to incorporate the local network computer of Cavill into the printer of Cavill (providing advantages such as simplified setup and more compact packaging by avoiding the need to provide this computer as a separate element externally interfaced with the printer).

Appellant's arguments do not directly address the obviousness of this specific modification (i.e. the incorporation of the Cavill local network computer into the Cavill printer as a single unit).

In the Cavill device *as modified in this manner as set forth in the outstanding Final Rejection*, the disclosed functions of the Cavill local network computer are performed by an element integrated into the printer. These functions include the determination of whether a print job can be locally processed, the division of a print job, and the sending of print tasks that cannot be performed locally to an external rendering device. Thus, in the Cavill device as modified in the manner set forth in the outstanding Final Rejection, the printer performs the operations of determining whether a print job can be locally processed, dividing the print job into portions, and sending

Art Unit: 2624

complex portions to an external rendering device (the external server).

Re claim 15, Appellant argues (5/25/05 Appeal Brief: page 10, lines 15-21) that Cavell does not teach or suggest that the printer separates a print task into multiple portions. Appellant further argues (5/25/05 Appeal Brief: page 10, lines 22-28) that Appellant's admitted Prior Art does not teach or suggest the determination of whether the entire print job can be processed by a printer or the sending of portions of a print job to an external device if it is determined that the printer cannot process them.

As argued above re claim 1, Examiner does not dispute these assertions concerning the teachings contained in these individual references. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further re claim 15, in addressing the combination of references upon which the outstanding rejection relies, Appellant argues (5/25/05 Appeal Brief: page 11, lines 1-7) that the combination of Cavill and Applicant's admitted Prior Art fails to teach or suggest a printer that determines whether a

Art Unit: 2624

print job can be processed by the printer. In particular, Appellant argues (5/25/05 Appeal Brief: page 11, lines 3-7) that neither of these references teaches or suggests that the printer may identify whether a print job can be processed by the printer, and that the combination therefore fails to teach or suggest these features.

As argued above re claim 1, Examiner notes that, as described in the outstanding Final Rejection, Cavill teaches a printer, a local network computer, and an external server. The network computer of Cavill determines whether a print job can be locally processed by the local network computer, and if not divides the job and sends complex portions thereof to the external server.

The outstanding Final Rejection notes that the incorporation of a processor into a printer is known in the prior art (citing Appellant's admitted Prior Art as a teaching to this effect). Examiner takes the position that it would be obvious to one of ordinary skill in the art to incorporate the local network computer of Cavill into the printer of Cavill (providing advantages such as simplified setup and more compact packaging by avoiding the need to provide this computer as a separate element externally interfaced with the printer). Appellant's arguments do not directly address the obviousness of

Art Unit: 2624

this specific modification (i.e. the incorporation of the Cavill local network computer into the Cavill printer as a single unit).

In the Cavill device *as modified in this manner as set forth in the outstanding Final Rejection*, the disclosed functions of the Cavill local network computer are performed by an element integrated into the printer. These functions include the determination of whether a print job can be locally processed, the division of a print job, and the sending of print tasks that cannot be performed locally to an external rendering device. Thus, in the Cavill device as modified in the manner set forth in the outstanding Final Rejection, the printer (specifically, the processor incorporated into the printer) performs the operations of determining whether a print job can be locally processed, dividing the print job into portions, and sending complex portions to an external rendering device (the external server).

Art Unit: 2624

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Stephen M Brinich
Examiner
Art Unit 2624

smb

August 3, 2005

Conferees

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Edward L. Coles

David K. Moore

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